

III. REMARKS

Claims 1, 12, 18, and 21 are amended to clarify what is intended to be covered. Claims 24-27 have been added. No new matter is presented. Claims 1-27 are presented for further consideration. Claim 9 is indicated to contain patentable subject matter if rewritten in independent form. Applicant has considered the Examiner's comments set forth in the Office Action mailed August 9, 2007 and responds in detail below. Reconsideration of the application is respectfully requested in view of the following remarks.

Applicant has amended the claims to clarify the novel features of the invention for which protection is sought in this application. The clarification has resulted from a better understanding of the Examiner's position gained from the office action of August 9, 2007.

Claims 1-8 and 12-23 stand rejected under 35USC102(e) on the basis of the cited reference Gilchrist, U.S. Patent No. 7,042,855. This rejection is traversed on the following grounds:

The cited reference Gilchrist fails to disclose each and every limitation of the claims of this application. It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221). In particular claim 1, states:

"transmitting a second data transmission service request from the mobile station to a second mobile network in response to the data transmission service not being providable substantially in accordance with the first data transmission service request and/or the terminal not being reachable via the local network.."

Independent claims 12, 18, and 21 contain equivalent language.

The reference Gilchrist fails to disclose or suggest this feature.

The disclosure of Gilchrist relates to a system for routing user traffic only within a local network. This is restated throughout Gilchrist, i.e., see column 2, lines 32-39, column 8, lines 59-63, and column 9, lines 56-67. It does not describe or suggest a way of providing for the transmittal of a new data transmission request to another network, as required by the claims of this application.

The Examiner indicates that Gilchrist discloses transmitting a service request from the mobile station to the public mobile network, referring to the following language in Gilchrist :

"Mobile station 201 desiring to transmit data via the GPRS network places a service request to SGSN 205. SGSN 205 enables mobile station 201 to transmit data after authenticating mobile station 201 and activating the service request at GGSN 207."

All of the elements described in this excerpt are part of the local network. At column 8, lines 1-10, referring to figure 5, Gilchrist describes the basic routing process as follows:

"FIG. 5 depicts a flow chart for representing the routing of packets from a mobile host to a wire line host. A frame is received (501) from a mobile station. The BSS determines (503) whether the downloaded context for the mobile station is in the routing table. If the downloaded context is not in the routing table, the BSS forwards (505) the frame to the Packet Data Gateway. The process then ends (599). The Packet Data Gateway forwards the frame to the appropriate packet data gateway. If the downloaded context for the mobile station is in the routing table, the BSS determines (507) if the destination address is local. If the address is not local, the BSS sends (509) the frame to the Packet Data Gateway. The process then ends (599). If the destination address is local, the BSS determines (511) if the destination address is for a mobile station. If the frame is not for a mobile station, the BSS forwards (513) the frame to a second network. If the frame is for a mobile station, the BSS forwards (515) the frame to the appropriate cell. The appropriate cell is the cell where the destination mobile station is currently affiliated. The process then ends (599)."

In the event a service request is not available within the local network, the data packet is merely routed to a gateway that is part of the local network. In the method and apparatus of the subject application, a message is transmitted back to the requesting mobile unit and the requesting mobile unit is adapted to send a second service request directly to another network. This is substantially different than the routing of a service request as described in Gilchrist. In Gilchrist the local network remains as a link in the transmission. No new service request is generated.

Therefore, Gilchrist fails to disclose the currently claimed combination of features, namely, the checking of the availability of the requested data transmission service and the reachability of a terminal (to which a connection is desired) in a local network and the transmission of a second service request from the originating mobile unit to a public mobile network in response to a lack of such availability or reachability in the local network or destination terminal.

The cited reference Gilchrist therefore does not support the rejection of any of the claims based on anticipation.

Claims 10 and 11 stand rejected under 35USC103(a) based on the reference Gilchrist in view of Voit, et al, U.S. Patent No. 6,870,827. This rejection is traversed on the following grounds:

The combined teaching of Gilchrist and Voit does not render claims 10 and 11 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20**

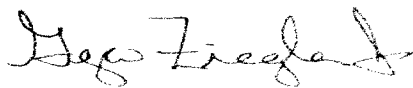
USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

In particular the combined teaching fails to disclose or suggest the claimed features of amended independent claims 1,12. 18, and 21 for the reasons indicated above. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. The cited reference Voit fails to remedy the deficiencies of the primary reference Gilchrist.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment of \$810 for the Request for Continued Examination, \$120 for a one-month extension of time and for any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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